

REMARKS

Claims 1, 6-8, and 13 are pending. Claim 1 is amended.

§ 112 Rejections

Claims 1, 6-8, and 13 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In the definition of R₁ in claim 1, the hydrogen atom on the amido group (-N-C(=O)-) is not shown. Claim 1 has been amended to show the hydrogen atom on the amido group (-NH-C(=O)-). Support for this amendment can be found, for example, at page 5, lines 7-9 of the specification.

In the definition of R₃ and R₄ in claim 1, "optionally containing one or more heteroatoms" has been deleted to focus the claim on the preferred group.

Accordingly, Applicants submit that the rejection of claims 1, 6-8, and 13 under 35 USC § 112, second paragraph, has been overcome, and respectfully request that the rejection be withdrawn.

Claims 1, 6-8, and 13 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement, allegedly because one of ordinary skill in the art is unable to make and use the instant compound as claimed without undue experimentation.

This rejection is traversed. Reconsideration and removal of the rejection is respectfully requested.

The claimed compounds can be made according to Reaction Scheme I wherein a compound of Formula IV is reacted with a dye derivative of Formula V to provide the claimed compound of Formula I. Starting materials of Formula IV required for preparing the claimed compound of Formula I are known to those skilled in the art. For example, U.S. Patent No. 5,693,811 (Lindstrom), incorporated by reference in the specification, describes the preparation of 6,7,8,9-tetrahydro-1H-imidazo[4,5-c]quinoline-4-amines wherein the substituent at the 1-

position (R₁) can be an aminoalkyl group. These compounds are known to be immunomodulators. See, for example, columns 1-3, and column 9, lines 27-30 of Lindstrom. In another example, U.S. Patent No. 5,352,784 (Nikolaides et al.), incorporated by reference in the specification, describes the preparation and immunomodulator activity of compounds having a fused 5- to 7-membered saturated ring, including compounds of Formula IV described in the specification of the present application

In view of the disclosure of the present invention, and using the guidance and direction provided therein, one skilled in the art could not only make, but also use the compounds as claimed without undue experimentation. Applicants have found that the presence of the dye moiety does not substantially reduce the biological activity of 1H-imidazo[4,5-c]quinolin-4-amines, and have included the corresponding compounds having a fused 5- to 7-membered saturated ring within the scope of the invention, given the known immunomodulator activity of the compounds having a fused 5- to 7-membered saturated ring. It is well-settled that it is not necessary that a patent applicant test all the embodiments of his invention in order to meet the requirements of 35 U.S.C. §112. *In re Angstadt*, 190 U.S.P.Q. 214, 218 (C.C.P.A. 1976).

Accordingly, Applicants submit that the rejection of claims 1, 6-8, and 13 under 35 USC § 112, first paragraph, has been overcome, and respectfully request that the rejection be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is respectfully requested.

Allowance of claims 1, 6-8, and 13, as amended, at an early date is solicited.

Respectfully submitted,

30 NOVEMBER 2004
Date

By: Dean A. Ersfeld
Dean A. Ersfeld, Reg. No.: 46,689
Telephone No.: (651) 733-7830

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833